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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,048	06/27/2003	Robert A. Juran	APPL 2 13460	7920

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EXAMINER

BOGART, MICHAEL G

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/608,048	Applicant(s) JURAN ET AL.	
	Examiner Michael G. Bogart	Art Unit 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 7,8,15,16,24,25 and 28-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,9-14,17-23, 26 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>08 September 2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

- I. Claims 1-6, 9-14, 17-23, 26 and 27, drawn to a stackable applicator, classified in class 222, subclass 187.
- II. Claims 7, 8, 15, 16, 24, 25, 28-36, drawn to a combination of an applicator with a cap structure, classified in class 215, subclass 200.
- III. Claims 37-40, drawn to a method of making an applicator, classified in class 425, subclass 500.

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the wetted foam could be substituted for wetted absorbent fibrous material. The subcombination has separate utility such as use without a cap structure.

Inventions I, II and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the

instant case the method can be employed to make a non-stackable applicator having a closed bottom portion.

During a telephone conversation with Tom Young on 25 August 2005 a provisional election was made with traverse to prosecute the invention of I, claims 1-6, 9-14, 17-23, 26 and 27. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7, 8, 15, 16, 24, 25 and 28-40 are withdrawn from further consideration by the examiner under 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

The drawings are acceptable for examination purposes only. One the application is allowed, new formal drawings must be submitted by Applicants.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6, 9-14, 17-23, 26 and 27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 11/108,522. Although the conflicting claims are not identical, they are not patentably distinct from each other because the 11/108,522 application claims every material limitation as that of the instant invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections – 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 17, 18, 21, 26 and 27 are rejected under 35 U.S.C. § 102(b) as being anticipated by Winston (US 5,431,098 A).

Regarding claims 17 and 26, Winston teaches a stackable product applicator (10) comprising:

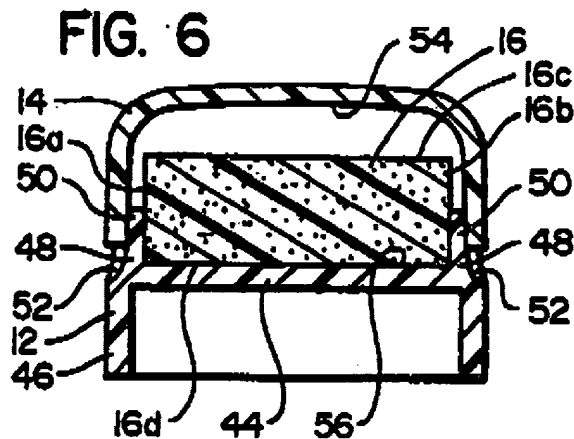
a rigid body comprising a base wall (44), a skirt (46) extending downwardly from said base wall (44), at least one upper side wall (50) extending upwardly from said base wall (44) having atop edge, a top (14) removably fixed to said side wall (50) around said entire top edge, said at least one upper side wall (50), said base wall (44) and said top (14) defining an upper compartment (56) having an openable closed top (14);

said skirt (46) and said base wall (44) defining a lower compartment having an open bottom;

a compressible foam body (16) received in said upper compartment (56), said foam body (16) adapted to extend above said at least one upper side wall (50) top edge when in an uncompressed state and be contained in said upper compartment (56) in a compressed state;

a quantity of fluid (ink) absorbed in said foam body(16); and

said skirt (46) being capable of surrounding and engaging the upper side wall (50) of an identical rigid applicator (10) whereby several applicators may be compactly stacked (see figure 6, below).



Regarding claims 18 and 27, the base wall (44) is integral with and effectively welded into the applicator body (12).

Regarding claim 21, the foam body (16) has a bottom surface (16d) adhered to said base wall (44)(column 3, lines 59-68).

Claims 1, 3, 9, 11, 17, 19, 20 and 21 are rejected under 35 U.S.C. § 102(b) as being anticipated by Gueret (EP 1 044 625 A1). For the purposes of specifically enumerating the features of the reference, the English language equivalent to Gueret is employed herein (US 6,334,727 B1).

Regarding claims 1 and 9, Gueret teaches a stackable applicator (1) comprising:

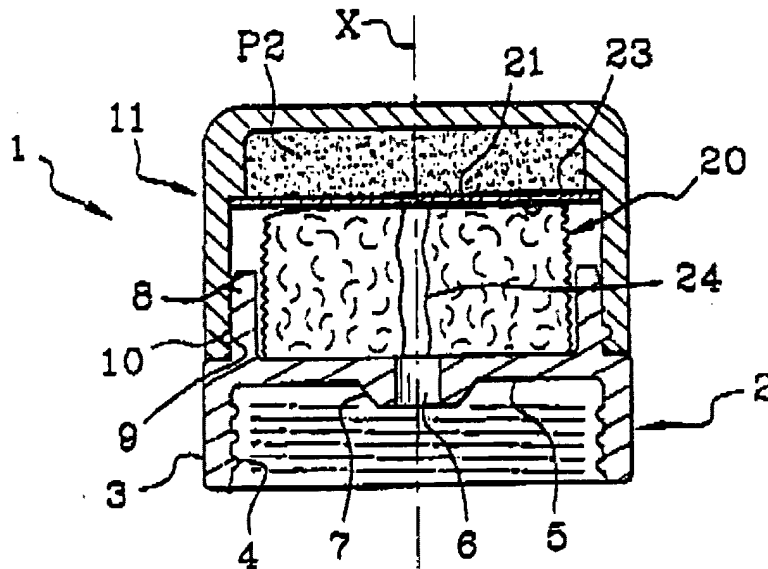
a rigid body (2) comprising a base wall (5), a skirt (3) extending downwardly from said base wall (5), at least one upper side wall (8) extending upwardly from said base wall (5) having a top edge, said at least one upper side wall (8) and said base wall (5) defining an upper compartment having an open top, said skirt (3) and said base wall (5) defining a lower compartment having an open bottom;

a compressible foam body (20) received in said upper compartment, said foam body (20) extending above said at least one upper side (8) wall top edge when in an uncompressed state;

a quantity of fluid absorbed in said foam body (20)(abstract);

a sealing film (11, 23) fixed to said at least one upper side wall (8) top edge compressing said foam body (20) into said upper compartment and sealing said upper compartment; and

said skirt (3) being capable of surrounding and engaging the upper side wall of an identical rigid body whereby several applicators may be compactly stacked (see figure 1A, below).



Regarding claims 3, 11 and 21, Gueret teaches that the foam body is adhered to the base wall (5).

Regarding claim 17, Gueret teaches a removable top (11).

Regarding claims 19 and 20, Gueret teaches that the foam body (20) is compressed in said upper compartment when the removable top (11) is in place, wherein removal of the top (11) allows the foam body (20) to extend through the top opening.

Claim Rejections – 35 USC § 103

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. § 103(c) and potential 35 U.S.C. § 102(e), (f) or (g) prior art under 35 U.S.C. § 103(a).

Claims 2 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gueret.

Gueret does not teach that the sealing film is heat sealed to the upper side top edge. Instead, it is sealed indirectly through cap means.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to substitute heat sealing for the mechanical seal because Applicant has not disclosed that heat sealing provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Gueret's applicator, and applicant's invention, to perform equally well with either mechanical seal taught by Gueret or the claimed heat sealing because both seals would perform the same function of sealing the upper compartment.

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Therefore, it would have been *prima facie* obvious to modify Gueret to obtain the invention as specified in claims 2 and 10 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Gueret.

Claims 4-6, 12-14, 22 and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gueret as applied to claims 1, 3, 9, 11, 17, 19, 20 and 21 above, and further in view of Boyd *et al.* (US 4,452,940).

Gueret fails to teach the concave design of the instant invention.

Boyd *et al.* teach a liquid container that has a concave construction (figures 1 and 2). This design makes the device easier to transport in a hip pocket. It also facilitates grasping the device.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to employ the concave design of Boyd *et al.* in the applicator of Gueret in order to make the device easier to grip and transport in a coat or hip pocket.

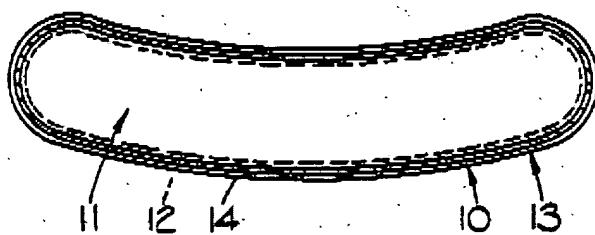


FIG. 2.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bogart whose telephone number is (571) 272-4933.

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In the event the examiner is not available, the Examiner's supervisor, Tatyana Zalukaeva may be reached at phone number (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300 for formal communications. For informal communications, the direct fax to the Examiner is (571) 273-4933.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-3700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michael Bogart
7 September 2005

TATYANA ZALUKAEVA
PRIMARY EXAMINER

